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Paper No.

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JUN 06 2005

OFFICE OF PETITIONS

In re Application of	:	
Riggs et al.	:	DECISION ON APPLICATION
Application No. 09/915,301	:	FOR
Filed: July 27, 2001	:	PATENT TERM ADJUSTMENT
Attorney Docket No. 6065/1	:	
	:	

This is a decision on the "PETITION FOR PATENT TERM ADJUSTMENT," filed February 28, 2005. Applicants request correction of the patent term adjustment of fifteen (15) days indicated in the notice of allowance. In part, applicants request reconsideration on the basis of the Office taking in excess of three years to issue the patent.

As it relates to the Office's failure to issue the patent within 3 years of the filing date, a decision is being **held in abeyance** until after the actual patent date. Knowledge of the actual date the patent issues is required to calculate the amount, if any, of additional patent term patentee is entitled to for Office failure to issue the patent within 3 years. See § 1.703(b).

Patentees are given **TWO (2) MONTHS** from the issue date of the patent to file a written request for reconsideration of the patent term adjustment for Office failure to issue the patent within 3 years. A copy of this decision should accompany the request. Patentees may seek such consideration without payment of an additional fee. However, as to all other bases for

seeking reconsideration of the patent term adjustment indicated in the patent, all requirements of § 1.705(d) must be met. Requests for reconsideration on other bases must be timely filed and must include payment of the required fee.

The application for patent term adjustment is GRANTED to the extent indicated herein.

The Office has updated the PAIR screen to reflect that the correct Patent Term Adjustment (PTA) determination at the time of the mailing of the Notice of Allowance is sixty-six (66) days. A copy of the updated PAIR screen, showing the correct determination, is enclosed.

On December 13, 2004, the Office mailed the initial Determination of Patent Term Adjustment under 35 U.S.C. 154(b) in the above-identified application. The Notice stated that the patent term adjustment to date is 15 days. On February 28, 2005, applicants timely submitted an application for patent term adjustment (with required fee)¹. Therein, applicants request reinstatement of 100 days of patent term adjustment on the basis that: 1) the term extension should not be reduced by 49 days because of applicants' submission of an Information Disclosure Statement after the first Office action; and 2) the term extension should not be reduced by 51 days for the filing of an a notice of appeal, as the notice was timely filed. In addition, applicants request that a further term extension should be granted; 1) pursuant to 35 USC 154(b)(1)(A)(i) for failure to provide a Notification under 35 USC 132 within fourteen months of the filing date; 2) pursuant to 35 USC 154(b)(1)(C) due to applicants' successful appeal; and 3) pursuant to 35 USC 154(b)(1)(B) for failure to issue the patent within 3 years of the filing date.

Applicants' arguments for reconsideration of the patent term adjustment at the time of the mailing of the notice of allowance have been considered, but not found entirely persuasive. For the reasons set forth below, it is concluded that the correct initial determination of PTA at the time of the mailing of the notice of allowance is 66 days.

¹ Palm Records indicate that the issue fee was received in the Office on March 9, 2005.

Re Reinstatement of 100 days of PTA

The reductions of 49 days and 51 days associated with the filing of an Information Disclosure Statement (IDS) and of a notice of appeal, respectively, have been considered.

The reduction of 49 days has been found to be correct. 37 CFR § 1.704(c)(8), provides that:

Submission of a supplemental reply or other paper, other than a supplemental reply or other paper expressly requested by the examiner, after a reply has been filed, in which case the period of adjustment set forth in § 1.703 shall be reduced by the number of days, if any, beginning on the day after the date the initial reply was filed and ending on the date that the supplemental reply or other such paper was filed;

Furthermore, § 1.704(d) provides that:

A paper containing only an information disclosure statement in compliance with §§ 1.97 and 1.98 will not be considered a failure to engage in reasonable efforts to conclude prosecution (processing or examination) of the application under paragraphs (c)(6), (c)(8), (c)(9), or (c)(10) of this section if it is accompanied by a statement that each item of information contained in the information disclosure statement was first cited in any communication from a foreign patent office in a counterpart application and that this communication was not received by any individual designated in § 1.56(c) more than thirty days prior to the filing of the information disclosure statement. This thirty-day period is not extendable.

It is undisputed that the IDS was filed on June 9, 2003, which is 49 days after applicants submitted their response to the first Office action. Moreover, the record does not support a conclusion that the IDS was expressly requested by the examiner. Thus, the IDS falls within § 1.704(c)(8) as an "other paper" not "expressly requested by the examiner."

The fact that the IDS was timely filed in compliance with 1.97(c) is not dispositive of whether the exception to § 1.704(c)(8) applies. In order for an IDS to fall within the

§ 1.704(d) exception, the only exception, it must be in compliance with 1.97 and 1.98. However, it must also include the statement "that each item of information contained in the information disclosure statement was first cited in any communication from a foreign patent office in a counterpart application and that this communication was not received by any individual designated in § 1.56(c) more than thirty days prior to the filing of the information disclosure statement." The IDS does not include the statement, and thus, does not fall within the exception set forth in § 1.704(d). The rules do not provide exceptions for IDSs falling within 1.704(c)(8), where the statement is deemed to be inapplicable. Accordingly, it is concluded that the entry of period of reduction of 49 days is proper.

On the other hand, the reduction of 51 days has been found to be incorrect. The record supports a conclusion that the notice of appeal (and fee) was originally filed on October 30, 2003. This was in response to, and within 3 months of, the letter mailed July 31, 2003, restarting the period for response to the final rejection². Accordingly, the reduction of 51 days, pursuant to § 1.704(b), is not warranted.

Re Office delay in issuing a Notification under 35 USC 132 not later than fourteen months after the application filing date

A period of adjustment of 110 days has been accorded because the Office did not issue a first Office action until January 15, 2003, fourteen months and 110 days after the application filing date. However, applicants contend entitlement to an additional 197 days on the basis that the Office action mailed January 15, 2003, did not comply with 35 USC 132, and a corrected Office action was not mailed until July 31, 2003. Specifically, applicants argue that the Office action did not include the reasons for the rejection of claims "together with such information and references as may be useful in judging of the propriety of continuing the prosecution of this application."

Applicants' argument is not well taken. It is clear that the 21-page Office action mailed January 15, 2003, is an action issued as a result of examination conducted pursuant to 35

² It was determined that the Office action mailed July 11, 2003 was not mailed to a correct correspondence address.

U.S.C. 131. See also Comment 4, *Changes to Implement Patent Term Adjustment under Twenty-Year Patent Term; Final Rule*, 65 Fed. Reg. 54366 (September 18, 2000). Accordingly, use of the January 15, 2003 date as the date for the first notification under 35 USC 132, and entry of a period of adjustment of 110 days is proper.

Re alleged Office delay due to applicants' successful appeal

Applicants request an extension of up to 409 days corresponding to the time period between the filing of the notice of appeal and the notice of allowance. Applicants state that it is not clear if the appeal was properly terminated at any time prior to the notice of allowance dated December 13, 2004, and reference FN1 on page 12 of their response filed November 23, 2004 (wherein applicants state that they would not agree to termination of the appeal). Alternatively, applicants request a patent term extension for the time period up to the Office action dated August 23, 2004 (316 days), the time period up to the withdrawn restriction requirement dated March 12, 2004 (122 days), or other appropriate time period.

Applicants' arguments have been considered, but are without merit. § 1.702(e) provides for a period of adjustment, as follows:

Delays caused by successful appellate review. Subject to the provisions of 35 U.S.C. 154(b) and this subpart, the term of an original patent shall be adjusted if the issuance of the patent was delayed due to review by the Board of Patent Appeals and Interferences under 35 U.S.C. 134 or by a Federal court under 35 U.S.C. 141 or 145, if the patent was issued under a decision in the review reversing an adverse determination of patentability. If an application is remanded by a panel of the Board of Patent Appeals and Interferences, and a notice of allowance under Sec. 1.311 is mailed without further review by the Board of Patent Appeals and Interferences, without further amendment of the application, and without other action by the applicant, the remand shall be considered a decision by the Board of Patent Appeals and Interferences as that phrase is used in 35 U.S.C. 154(b)(1)(A)(iii) and a decision in the review reversing an adverse determination of patentability as that phrase is used in 35 U.S.C. 154(b)(1)(C)(iii).

There was no decision by the Board of Patent Appeals and Interferences (or by a Federal court). Accordingly, entry of a period of adjustment based on delay caused by successful appellate review is not warranted.

CONCLUSION

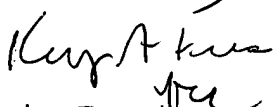
In view thereof, the correct patent term adjustment at the time of mailing of the notice of allowance is **sixty-six (66)** days.

Petitioner is reminded that if an application is entitled to an adjustment under 35 U.S.C. 154(b)(1)(B), the entire period during which the application (except for periods excluded under 35 U.S.C. 154(b)(1)(B)(i)-(iii)), and not just the period beginning three years after the actual filing date of the application, is the period of delay under 35 U.S.C. 154(b)(1)(B) in determining whether periods of delay overlap under 35 U.S.C. 154(b)(2)(A). Thus, any days of delay for Office issuance of the patent more than 3 years after the filing date of the application which overlap with the days of patent term adjustment accorded prior to the issuance of the patent will not result in any additional patent term adjustment. See 35 U.S.C. 154(b)(1)(B), 35 U.S.C. 154(b)(2)(A), and 37 CFR § 1.703(f). See also Revision of Patent Term Extension and Patent Term Adjustment Provisions; Final Rule, 69 Fed. Reg. 21704 (April 22, 2004).

The Office acknowledges submission of the \$200.00 fee set forth in 37 CFR 1.18(e). No additional fees are required.

The application file is being forwarded to the Office of Patent Publication for issuance of the patent.

Telephone inquiries specific to this matter should be directed to Nancy Johnson, Senior Petitions Attorney, at (571) 272-3219.


Karin Ferriter
Senior Legal Advisor
Office of Patent Legal Administration
Office of Deputy Commissioner
for Patent Examination Policy

Enclosure: Copy of REVISED PAIR Screen